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**THIS DISPOSITION
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Paper No. 9
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Birds Exotic, Inc.

Serial No. 75/646,179

Norman E. Lehrer for Birds Exotic, Inc.

Michael D. Tinyk, Trademark Examining Attorney, Law Office
101 (Jerry Price, Managing Attorney).

Before Hanak, Hairston, and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On February 19, 1999, Birds Exotic, Inc. (applicant)
filed a trademark application to register the mark BIRDS
EXOTIC (typed drawing) for services identified as "retail
store services featuring live pet birds and pet supplies"
in International Class 35.¹

¹ Serial No. 75/646,179. The application alleges a date of first
use and a date of first use in commerce of May 5, 1982.
Applicant has disclaimed the word "birds."

The Examining Attorney refused to register the mark on the ground that the mark, when applied to the services, is merely descriptive. 15 U.S.C. § 1052(e)(1). After the Examining Attorney made the refusal final, applicant filed a notice of appeal. Both applicant and the Examining Attorney have filed briefs, but no oral hearing was requested.

We affirm the Examining Attorney's refusal to register.

The Examining Attorney's² position is that "the words, EXOTIC and BIRDS, are used to describe birds that are exotic, meaning, birds that are not indigenous to the area in which they are found. Furthermore, the combination of "BIRDS" and "EXOTIC" fails to create a unique or incongruous impression that would overcome the descriptive meaning." Examining Attorney's Appeal Brief, p. 4. The Examining Attorney attached LEXIS/NEXIS printouts, which showed that the term "exotic birds" was a commonly used term to refer to birds and the stores that sell them.

Bird Crazy, a retail exotic-bird store that's found its perch. *San Diego Union-Tribune*, April 11, 1998, p. C3.

² The current Examining Attorney was not the original Examining Attorney in this case.

This is a retail and wholesale pet store and [it] has some of the most exotic birds ever seen. *Orange County Register*, March 7, 1998, F7.

The federal government had cracked down on the trade of exotic birds by then. *The Stuart News/Port St. Lucie News*, July 28, 1996, p. E1.

There are ten varieties of exotic birds for sale. *The Charleston Gazette*, February 24, 2000, p. 2.

We couldn't afford to put exotic birds in an aviary that we built in the center of our store, so we went to the State Fair and got exotic chickens to fill it. *The Times Union (Albany, NY)*, October 31, 1999, p. H1.

Pet stores have been warned about a man selling exotic birds. *Knoxville News-Sentinel*, April 3, 1999, p. A10.

The Examining Attorney concluded that "the transposition of the terms in the proposed mark simply does not provide enough distinction to require any imagination to associate the services with the proposed mark, and therefore, create a merely suggestive mark." Examining Attorney's Appeal Brief, p. 10.

Applicant, on the other hand, maintains that the mark is not merely descriptive. "The mark simply does not provide the consumer with enough information to provide him or her with an essential understanding of Applicant's services." Applicant's Appeal Brief, p. 2. Because imagination would be required to understand the mark in relation to the services and the lack of a competitive need

by others to use the term BIRDS EXOTIC, applicant submits that its mark is not descriptive.

Before we discuss the descriptiveness issue, we must address a potential problem in the record. When the application in this case was filed, it requested "that said mark be registered in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946, as amended *particularly pursuant to 15 U.S.C. § 1052(f)*." (Emphasis added). The application also contained the following statement:

The undersigned believes that the mark has become distinctive, as applied to applicant's services, by reason of substantially exclusive and continuous use thereof as a service mark by the applicant in commerce for more than 16 years prior to the date of filing of this application.

In the first Office Action, the Examining Attorney advised applicant that it had the option to seek registration on the Principal Register under Section 2(f) with a disclaimer of the word "birds." The Examining Attorney included language for a claim of distinctiveness. However, applicant responded to the first Office Action by disclaiming the term "birds," but then arguing that the term BIRDS EXOTIC was "obviously highly suggestive," but not merely descriptive. Response dated December 17, 1999, p. 2. Subsequently, applicant has argued that it "most

strenuously but respectfully disagrees" with the Examining Attorney's position that the mark is descriptive.

Applicant's Appeal Brief, pp. 1-2.

Neither the Examining Attorney nor applicant have referred to the request for registration under Section 2(f) contained in the application as filed. Indeed, applicant has consistently maintained that the mark is suggestive. Therefore, we conclude that the request for registration under Section 2(f) was either a typographical error or subsequently withdrawn by applicant. In either event, we will respond to the arguments of applicant and the Examining Attorney on the issue of descriptiveness without consideration of Section 2(f).³

A mark is merely descriptive if it immediately describes the ingredients, qualities, or characteristics of the goods or services or if it conveys information regarding a function, purpose, or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978). A term may be held descriptive even if it only describes one of the qualities or properties of the goods or services. In re Gyulay, 820

³ We note that, other than the claim of sixteen years use, no evidence concerning acquired distinctiveness was submitted by applicant.

F.2d 1216, 1217, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). We look at the mark in relation to the goods or services, and not in the abstract, when we consider whether the mark is descriptive. Abcor, 588 F.2d at 814, 200 USPQ at 218.

Applicant argues that "imagination, thought and perception must be exercised in order to reach a conclusion as to the nature of the services" and that "[o]ne would not know, for example, whether Appellant sells live birds or books or films about birds." Applicant's Appeal Brief, p. 2. Considered in relation to applicant's retail store services featuring live pet birds and pet supplies, as we must do, there can be no doubt but that the term BIRDS EXOTIC at least merely describes the fact that applicant sells exotic birds and supplies for exotic birds.

Here, the Examining Attorney has submitted ample evidence that the term "Birds Exotic" is highly descriptive. Applicant concedes that the term "exotic birds" is merely descriptive. Response dated December 19, 1999, p. 2 ("If Applicant was attempting to register the mark EXOTIC BIRDS, one would have to agree the mark was merely descriptive"). In addition, the Examining Attorney's printouts confirm that the term "exotic birds" is commonly used to refer to birds and pet stores featuring

exotic birds.⁴ Examples include: "retail/exotic bird dealer," "store carries 70 varieties of food for exotic birds," and "[t]his is a retail and wholesale pet store and has some of the most exotic birds ever seen." Thus, the term is highly descriptive of a pet store that sells exotic birds and supplies for exotic birds.

Applicant argues that there is no need for competitors to use the term BIRDS EXOTIC in identifying their services. Applicant relies on Aluminum Fabricating Co. v. Season-All Window Corp., 259 F.2d 314, 119 USPQ 61 (2d Cir. 1958) and No Nonsense Fashions, Inc. v. Consolidated Food Corp., 226 USPQ 502 (TTAB 1985) for support of its proposition that that there are numerous other terms that competitors could utilize, and registration of its mark would not make it difficult for other businesses to describe their products. These cases and applicant's arguments do not convince us that its mark is not descriptive of its services. First,

⁴ We also note that Federal law and regulations define and refer to "exotic birds."

16 U.S.C. § 4901 - "The Congress finds the following: (1) In addition to habitat loss and local use, the international pet trade in wild-caught exotic birds is contributing to the decline of the species in the wild."

50 CFR § 15.3 - "Exotic bird means any live or dead member of the Class Aves that is not indigenous to the 50 States or the District of Columbia, including any egg or offspring thereof."

7 CFR § 1945.154 - A nonfarm business enterprise may include, but is not limited to, such enterprises as custom farm work on other farms, raising earthworms, exotic birds, tropical fish, dogs and horses for nonfarm purposes. . . ."

the marks in Aluminum Fabricating (SEASON-ALL for aluminum storm doors and windows) and No Nonsense (SHEER ELEGANCE for hosiery products) were not as highly descriptive of the goods as applicant's mark (BIRDS EXOTIC for retail store services featuring live birds) is of the identified services. Obviously, applicant's identification of services would include the sale of exotic birds. Secondly, there is no rule that the simple transposition of words changes a descriptive term into a non-descriptive term. "The mere transposition of words is generally insufficient to create trademark rights in an otherwise common descriptive term or designation." In re Dairimetics, Ltd., 169 USPQ 572, 573 (TTAB 1971) quoting In re Vasco Metals Corp., 154 USPQ 191 (TTAB 1967). The rule has equal applicability to merely descriptive terms. Third, the transposition of the words in this case does not create a term with a different meaning or commercial impression. While "season all" and "all season" may have different impressions, "exotic birds" and "birds exotic" have the same commercial impression when applied to retail pet store services featuring live pet birds, i.e., that the store sells exotic birds. Finally, there is no evidence to support applicant's argument that its competitors would not need to use the term "Birds Exotic." Certainly,

competitors would need to use the term "exotic birds."

While the Examining Attorney did not believe that there was a need for competitors "to use the exact wording BIRDS EXOTIC" (Examining Attorney's Appeal Brief, p. 9), the term "exotic birds" unequivocally describes applicant's services. Competitors would need to use these words in various ways to refer to their services, and it is not clear why they would not, on occasion, transpose the terms for either the sake of variety or to emphasize the general term "birds" before the more specific term "exotic."

However, even if they would not, since the terms "exotic birds" and "birds exotic" would be synonymous, applicant's term is merely descriptive for its retail store services.

Decision: The Examining Attorney's refusal to register the mark BIRDS EXOTIC on the ground that it is merely descriptive of the involved services is affirmed.